

REMARKS

This responds to the Office Action mailed on October 14, 2004.

Claims 1, 5 and 9 are amended; as a result, claims 1-5, 7 and 9 are now pending in this application.

§103 Rejection of the Claims

Claims 1-5, 7, and 9 were rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over U.S. Patent No. 6,092,074 (hereinafter Rodkin) in further view of U.S. Patent No. 6,651,058 (hereinafter Sundaresan).

Applicants respectfully submit that claims 1-5, 7, and 9 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application. Reasons for rejection of claims 1-5, 7, and 9 appear below.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitation:

designating a name for a product; and
storing the name of the product as one of the character strings in the database

The Final Office Action, in rejecting claim 1, contends that the above limitation is anticipated by the following disclosure in Rodkin:

The method may comprise the further steps of receiving designated character strings from the primary computers via the communication network in the periodic maintenance

mode; wherein the designated character strings are designated by an administrator input at the primary computers; updating the annotation database with the designated character strings if the designated character strings are not present in the annotation database.

The above quote from Rodkin describes a method for receiving a character string in a maintenance mode. The character string is designated by an administrator at one or more primary computers and communicated to a central computer (Col. 9, line 64). The central computer receives the character string and updates an annotation database with the character string if the character string is not present in the annotation database.

Claim 1 requires designating a name for a product and storing the name of the product as one of the character strings in the database. For example, one name (e.g., a character string) may be designated from multiple names as a “shortname” for a product and stored in a database for inserting relevant hyperlinks (page 19). In contrast, the above quote from Rodkin does not describe designating a name for a product and storing the name of the product as one of the character strings in the database; but rather, designating a character string that may not be present in a database. Indeed, Rodkin further describes the above-mentioned maintenance mode (Col. 11, lines 33–39) as including content servers that communicate new character strings to a central server, “Accordingly, during the maintenance mode ...the central server [is] updated with new terms” (Id.). Clearly designating a name for a product is not the same as designating a new character string. Rodkin therefore cannot be said to anticipate the above quoted limitation because Rodkin discloses designating a new character string and claim 1 requires designating a name for a product and storing the name of the product as one of the character strings in the database.

Independent claim 9 includes a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of this independent claim.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-5, and 7 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Rodkin in combination with Sundaresan does not teach or suggest each and every limitation of claims 1-5, 7, and 9 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

In summary, Applicants believe that all rejections presented in the Final Office Action have been fully addressed and withdrawal of these rejections is respectfully requested. Applicants are mindful that the proposed amendment cannot, as a matter of right, be entered. Nonetheless, Applicants believe that the proposed amendment requires only a cursory review by the Examiner to remove issues from appeal. Applicants furthermore believe that all claims are now in a condition for allowance, which is earnestly solicited.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14 day of January, 2005.

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